

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s)	Stoltze et al.	Examiner:	Erezo, D.P.
Serial No.:	10/020,592	Group Art Unit:	3773
Confirmation No.:	6947	Docket:	760-46 CIP/PCT/USA/ CON II/RCE II
Filed:	December 12, 2001	Dated:	January 5, 2011
For:	CATHETER WITH A STENT AND METHOD FOR THE PRODUCTION OF A CATHETER WITH STENT		

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**BRIEF ON APPEAL PURSUANT TO 37 C.F.R. §41.37**

Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the decision mailed August 9, 2010 in which the Examiner finally rejected claims 41 and 42 in the above-identified application. Claims 25-35, 45 and 46 are allowed and the Examiner has indicated that claims 43 and 44 contain allowable subject matter. Appellants have filed a timely Notice of Appeal on November 8, 2010. This Appeal Brief is being filed in support of the Notice of Appeal. Please charge the filing fee of \$540.00 to Deposit Account No. 08-2461. Please charge any additional fees and credit any overpayments to Deposit Account No. 08-2461.

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I. REAL PARTY IN INTEREST

The real party in interest is Boston Scientific Scimed, Inc., the assignee of the entire, right, title and interest in and to the present application.

II. RELATED APPEALS AND INTERFERENCES

In related U.S. Patent Application No. 11/541,792 (the “’792 Application”), a timely Notice of Appeal was filed on September 1, 2010. A Brief on Appeal was filed on January 3, 2011. Both the present application and the ‘792 Application share a common priority claim.

There are no other related appeals or interferences known to Appellant or Appellant’s legal representative which will directly affect or be directly affected by or having a bearing on the Board’s decision in this Appeal.

III. STATUS OF THE CLAIMS

Claims 25-45 are pending.

Claims 25-35, 45 and 46 are allowed.

Claims 41 and 42 are rejected.

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Claims 43 and 44 are objected to.

Appellant is appealing the rejection of claims 41 and 42.

#### IV. STATUS OF AMENDMENTS

In response to the final rejection mailed August 9, 2010, a timely Notice of Appeal was filed on November 8, 2010. No amendments or arguments were presented after Final Rejection. In addition, no further amendments have been presented after the filing of the Notice of Appeal.

#### V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following is concise explanation of the subject matter defined in each of the independent claims presently on appeal with reference to the specification by page and line number and to the drawings by reference character.

Claim 41 is the sole independent claim on appeal.

As set forth in claim 41, the present invention provides a method for forming a stent delivery device (catheter 1) (page 12, lines 28-30). The steps of the claimed method include providing a catheter 1 having an inflatable portion 2 (page 12, line 27 through page 13, line 1). A stent 3 is placed around the inflatable portion 2 (page 13, lines 1-2, Figures 1 and 2). The stent

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3 is releasably retained to the inflatable portion 2 by depressions formed therein (page 13, line 30 through page 14, line 4, Figures 6A and 6B).

#### VI. THE GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 41 and 42 are anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,969,485 to Witkor (hereinafter "Witkor").

#### VII. ARGUMENTS

A. Claims 41 and 42 are not anticipated under 35 U.S.C. §102(b) by Witkor.

Claim 41 on appeal recites a method of forming a stent delivery device comprising the steps of providing a catheter having an inflatable portion, placing a stent on the inflatable portion and releasably retaining the stent to the inflatable portion by depressions formed therein.

Specifically recited in claim 41 is that the stent is releasably retained by depressions that are formed in the inflatable portion. Quite simply, the stent of Witkor is not releasably retained by depressions formed in the Witkor balloon (inflatable portion).

Turning to Figure 2 of Witkor, it is the Examiner's contention that the loops 6 of the stent 1 are shown retained in depressions in the balloon. However, the only clear disclosure in Witkor

is that the curved end portions (reversing loops of the stent 6) lie against the surface of balloon 7. While portions may push the balloon material down, as indicated by stress lines shown in Figure 2, there is absolutely no disclosure with respect to Figure 2 nor elsewhere in the specification of Witkor that the stent is releasably retained within depressions formed in the balloon. Moreover, Witkor at column 3, lines 24-28, describes that the reversing loops of the stent are "lightly crimped." Thus, the loops grip the balloon to provide sufficient friction to prevent the stent from sliding and slipping. This does not rise to the disclosure of releasably retaining the stent within depressions formed in the balloon.

The method of the present invention relies on actual depressions formed in the balloon into which the stents reside. This is clearly shown in Figures 6A and 6B of the present application. By placing the stent within the depressions, the stent is releasably retained by the balloon as the balloon is moved through an artery so that the stent may be positioned at a desired location. In contrast, Witkor relies on light gripping of the stent to frictionally retain the stent on the balloon.

It is well settled that for a reference to anticipate a claim, each and every element of the claimed invention must be disclosed in the single prior art reference. *Zenith Elecs. Corp. v. PDI Commun. Sys., Inc.*, 522 F.3d 1348, 1363 (Fed. Cir. 2008).

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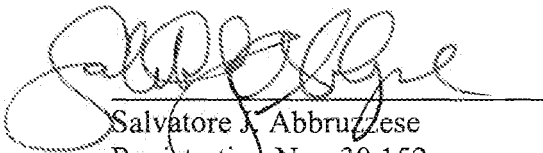
With respect to method claims, the test for anticipation is the same. Anticipation requires identity between the claimed process and the process shown in the prior art. Thus, the claimed process including each step thereof must be described or embodied, either expressly or inherently in a single reference. *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 45 F.3d 1550, 1554 (Fed. Cir. 1995).

As Witkor fails to clearly disclose a limitation set forth in independent claim 41, namely resiliently retaining a stent to a balloon by depressions formed therein, it is submitted that claim 41 is not anticipated by Witkor. Moreover, claim 42 which depends from claim 41 is similarly not anticipated by virtue of its dependency.

#### VIII. CONCLUSION

For the reasons set forth hereinabove, the Examiner's final rejection of the claims should be reversed.

Respectfully submitted,



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VIII. Claims Appendix

41. A method of forming a stent delivery device comprising the steps of:  
  
providing a catheter having an inflatable portion;  
  
placing a stent on the inflatable portion; and  
  
releasably retaining said stent to said inflatable portion by depressions formed therein.
  
42. A method of claim 41 wherein said releasably retaining step includes:  
  
placing said inflatable portion and said stent in a softening device.

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IX. Evidence Appendix

None.



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X. Related Proceeding Appendix

U.S. Patent Application No. 11/541,792, filed October 2, 2006.